

SCHERING-PLOUGH CORPORATION
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K-6-1, MAIL STOP 1990
KENILWORTH, NEW JERSEY 07033
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(703) 872-9306

FROM: Anita W. Magatti

PHONE NUMBER:
(908) 298-5067

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DATE
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NOTES/COMMENTS:

In re Application of: Robert G. Aslanian *et al.*
For Patent Entitled: Indole Derivatives Useful as Histamine H₃ Antagonists
Filed: 06/20/2003

Attorney Docket No.: AL01583K1
Serial No.: 10/600,674
Art Unit: 1625

Transmitted herewith are:

- Fax Cover Sheet (1 pg.)
- Certificate of Transmission under 37 CFR 1.8 (1 pg.)
- Response to Restriction Requirement (3 pgs.)
- References: Therapeutic potential of histamine H₃ receptor agonists and antagonists (7 pgs.)


Anita W. Magatti
Registration No. 29,825

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PHONE: (908) 298-5067

FAX: (908) 298-5388

Attorney Docket No.: AL01583K1

Application No.: 10/600,674

Filing Date: 06/20/2003

First Named Inventor: Robert G. Aslanian et al.

PTO/SB/97 (06-03)

Approved for use through 07/31/2006. OMB 0651-0031
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Document(s) being transmitted:

Response To Restriction Requirement (3 pgs.)

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PATENT
CASE AL01583K1IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Robert G. Aslanian et al

For Patent For:

Indole Derivatives Useful as
Histamine H₃ Antagonists

Examiner: C. Chang

Art Unit: 1625

Serial No.: 10/600,674

Filing Date: June 20, 2003

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Schering-Plough Corporation
Kenilworth, New Jersey 07033-0530Commissioner for Patents
PO Box 1450
Alexandria VA 22313-1450RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This is in response to the Restriction Requirement mailed July 8, 2004, a response to which is due August 8, 2004.

The Restriction Requirement identified five groups: Group I, claims 1 to 15 and 17-19, drawn to bispiperidinyl indolyl compounds and a single method of use; Group II, claims 1-14, 16-19, drawn to pyrrolidinylpiperidinyl indolyl compounds and a single method of use; Group III, claims 1-14, 16-19, drawn to azepidinyl piperidinyl indolyl compounds and a single method of use; Group IV, claims 1-14 and 16, drawn to the remaining compounds; and Group V, claims 20-24, drawn to combinations.

Certificate of Transmission

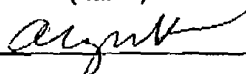
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Anita W. Magatti
(name)

Signature



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Applicants hereby elect Group I, bispiperidiny l indolyl compounds without traverse. However, applicants elect the treatment of congestion with traverse, as discussed further below.

Applicants respectfully traverse the requirement that the claims be limited to a single disorder to be treated by the compounds. Applicants urge that conditions known in the art to be treated by H₃ antagonists, such as those included in claim 17, should be considered together; see, for example, Leurs et al, TIPS, 19 (1998), p. 177-183, copy attached, wherein H₃ antagonists are said to be potentially useful in treating a variety of diseases. Also, applicants note that in US 6,720,328 B2, the US equivalent of PCT US01/32151 cited in the specification as disclosing H₃ antagonists, a method claim was granted for the treatment of allergy, allergy-induced airway responses, congestion, obesity, hypersomnia, narcolepsy, schizophrenia and migraine.

Alternatively, applicants urge that at least closely related diseases should be grouped together for consideration, e.g., allergy-induced airway response disease, allergy and nasal congestion.

Applicants realize that the claims need to be amended in view of the restriction requirement, but before the claims are amended, applicants question the reference to "1,2,3-indolyl," in view of claim 15 being the basis for Group I. All the compounds in claim 15 have the indolyl group joined at the 3-position, but applicants wish to confirm that the reference to "1,2,3-indolyl" indicates that the indolyl group can be joined at the 1, 2 or 3 position, not that the indolyl is joined thorough the 3-position and the remaining two atoms in the nitrogen-containing ring of the indolyl can substituted. Clarification is respectfully requested.

No change in inventorship is believed to be necessary in view of the election of Group I, but when the scope of "1,2,3-indolyl" is confirmed, applicants will review the matter again, if necessary.

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Applicants reserve the right to pursue non-elected inventions in one or more divisional applications.

Respectfully submitted,



Anita W. Magatti
Reg. No. 29,825
Attorney for Applicants
(908) 298-5067